

## REMARKS

Claims 1-20 are pending.

The Office Action rejected claims 1-10 and 12-17 under 35 U.S.C. 102(e) as anticipated by U.S. Pat. App. Pub. No. 2003/0130070 to Nolan. Claim 11 was rejected under 35 U.S.C. 103(a) as obvious over Nolan. Claims 18-20 were also rejected under 35 U.S.C. 103(a) as obvious over Nolan in view of U.S. Pat. No. 5,484,146 to Loschiavo.

## Traverse

### Anticipation Rejection

It is respectfully submitted that the characterization of Nolan's pouches in the Office Action as "means for securing the at least 1 weight" is inaccurate. Nolan's pouches for holding the weights do not secure the belt to the baseball bat; they constitute the weight bearing, that is the weight holding, portion of the belt. This is borne out by the construction of the Nolan weight belt, which is made of two layers of flexible material. The first layer constitutes a hook and loop fastening system (Nolan ¶ 17). The second layer forms a weight cover (Nolan ¶ 30). The attachment, preferably by sewing, of the weight cover to the hook and loop layer forms pockets into which the weights engage and results in the Nolan weight belt (Nolan ¶¶ 30, 31 and claim 1).

The only fully disclosed means for securing the Nolan weight belt to the baseball bat is an extension of the hook and loop fastening layer, which is preferably Velcro®, beyond the portion of the belt containing the weight pockets (Nolan ¶¶ 17, 32, Fig. 1, claim 1). As for other means of securing, Nolan merely mentions, without fully supporting disclosure or depiction, that the weight belt may be secured to a baseball bat via a series of snaps (Nolan ¶ 32). Further, Nolan limits its securing means in claim 1 to a hook and loop fastening system and limits in claim 6 that its weight training belt comprises "a two part fastening means, one part of the fastening means on the front face [of the first layer]] and the second part of the fastening means on the back face [of the first layer]. Reading as broadly as possible into the Nolan disclosure, one of skill in the art would understand that the securing means for Nolan's belt consists only of a hook and loop fastening system or a series of snaps.

The current amendments recite that the means for securing the recited weight or weight holder do not include a hook and loop fastening system or snaps. Consequently, Nolan does not teach the means for securing the present weight or weight holder to either face of a hockey stick blade disclosed in the present application. Since the claim amendments remove the anticipation rejection, applicant respectfully requests the withdrawal of this rejection.

#### Obviousness Rejections

The Office Action (pg. 2) bases its obviousness rejection of claim 11 over Nolan on the “common sewing technique” of “folding a single sheet over and sewing it to form the pocket”. This technique is considered similar to the formation of Nolan’s casing pockets “from two sheets of material sewn together.”

As discussed above, Nolan discloses that its weight belt is constructed of two layers of flexible material, one a hook and loop fastener and the other a weight cover, which are preferably sewn together to create weight-holding pockets. The pockets may be “sewn closed permanently” or not, in order to remove the weights (Nolan ¶¶ 19, 31).

The present application discloses no sewing technique to form the casing. Moreover, neither the description nor the drawings suggest a sewn casing. The specification at ¶ 26 states that particularly useful casing material includes polyester films such as Mylar®, polyethylene films, Latex® and the like. These are flexible enough to allow weights to be positioned on them and then folded over to create a neat, precise enveloping casing. This enveloping casing is conformable to the hockey blade and may be secured to the blade using a disclosed means for securing, particularly hockey tape. Paragraph 25 discloses other and heavier weight casing material, such as metal or wood, or vinyl, rubber, plastic, glue, epoxy, resin etc. These enumerated casing materials do not lend themselves to being sewed “to form a pocket”.

Moreover, materials such as fabric, canvas and webbing, which are disclosed in Nolan as weight cover materials, are not disclosed in the present application. The Office Action presumes from Nolan that the present casing of claim 11 will be sewn to form a

pocket. This presumption is totally without support from the present description or drawings, which neither disclose nor intimate a sewn casing.

The rejection does not present a prima facie case of obviousness. Nolan cannot teach or suggest this invention inasmuch as its weight belt contains two layers attached to each other by sewing, one layer being the means for securing and the other layer being the weight casing. In the present invention, the means for securing and the weight casing are not attached to each other by sewing, but form two separably distinct elements. Even if it would have been obvious to one in the art "to form pockets by folding a single sheet over and sewing it to form the pocket", forming such a pocket does not speak to, suggest or hint at the invention recited in claim 11. Applicant respectfully requests the withdrawal of this rejection.

The rejection over Nolan in view of Loschiavo does not disclose all of the elements of claims 18-20. Nor does it motivate for the combination of Nolan with Loschiavo. Consequently, it fails to state a prima facie case of obviousness.

As an adjustable weight training belt for use in practice with a baseball bat (Abstract, Nolan ¶ 17), the Nolan invention aims to provide an adjustable, and therefore, more appropriate placement about the bat than ordinary doughnut-type weights (Nolan ¶ 12). Its goal is to allow a player to position the belt around the bat at the same vertical location, regardless of the thickness of the bat (Nolan ¶ 14). The technical solution here is to attach a strip of hook and loop fastening, e.g., Velcro®, to a weight holder. It is the Velcro® strip that enables the belt to encircle bats of different volumes, but to sit at the same vertical height regardless of bat thickness (Nolan ¶ 32).

Although Nolan mentions the use of its weight belt in a generic "hand held athletic tool", the disclosed elements of the Nolan belt relate solely to the technical problem of situating a weight belt at a determinable vertical location on a baseball bat in order to fit bats of variable volumes. There is no discussion whatsoever, and therefore no suggestion or motivation, as to how the Nolan weight belt would work with different hand held athletic tools and particularly with a hockey stick, whose overall configuration differs greatly from

that of a baseball bat. At best, the Nolan disclosure would teach or motivate one skilled in the art to use the Nolan weight belt around the hockey stick and not on the blade.

Importantly, Nolan provides no motivation for positioning its weight belt to fit within the surface of a hockey blade as there is absolutely no discussion as to how its belt might work with a hockey stick. The assertion that the Nolan weight belt around a baseball bat motivates or suggests that the present invention fit within the surface of a hockey blade is wholly unsupported by the Nolan disclosure and constitutes impermissible hindsight. Ultimately, the test as to whether the reference teaches or motivates towards the combination is that the “nature of the problem to be solved as a whole would have suggested to those of skill in the art” [MPEP § 2143.01]. There is no connection between the nature of the technical problems solved by the Nolan weight belt and by the present invention.

Loschiavo discloses a hockey blade weight that snaps on and thereby hangs over the top edge of the blade. Although the Loschiavo invention is a blade weight, it does not motivate for fitting the weight within the surface of a hockey blade. To the contrary, Loschiavo teaches that a hockey blade weight does not lie within the blade face but hangs over the face from the top perimeter or, in another embodiment, also extends along the stick via a flange. In particular, Loschiavo does not teach, among others, the following elements of claims 18 – 20: a weight of a size and configuration as to fit within the surface area of the face to which it is secured; or positioning the weight to fit within the surface area of the blade. As with Nolan, the technical problem solved by Loschiavo is not the one solved by the present invention. Loschiavo concerns “minimizing [the] need for adhesive securement and attachment of the weight member thereto” (Loschiavo, col. 2, lines 51-52), and therefore cannot motivate for combining the references to arrive at the present invention.

Loschiavo and Nolan, singly or in combination, do not claim all the recited elements and cannot motivate for combining the references. Neither reference nor the combination suggests the desirability of or the nature of the problem solved by the present invention. Accordingly, this rejection does not state a prima facie case of obviousness. Applicant respectfully requests its withdrawal.

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Office Action dated 16 June 2004  
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Page 10 of 10

In view of the foregoing, allowance of the present application is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Loretta Smith".

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